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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224316
Party	Defendant Natalus Australia Pty Ltd
Correspondence Address	ROBERT B BURLINGAME PILLSBURY WINTHROP SHAW PITTMAN LLP PO BOX 2824 SAN FRANCISCO, CA 94126-2824 sftrademarks@pillsburylaw.com, rburlingame@pillsburylaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Robert B. Burlingame
Filer's e-mail	sftrademarks@pillsburylaw.com, rburlingame@pillsburylaw.com
Signature	/Robert B. Burlingame/
Date	12/29/2015
Attachments	NATRALUS - First Amended Answer and Counterclaim.pdf(348836 bytes)

)	
Brands Worldwide Holdings I.P. Pty Limited,)	Opposition
)	No. 91224316
Opposer,)	
)	
v.)	Ser. No. 86336621
)	Mark: NATRALUS
Natralus Australia Pty Ltd,)	
)	
Applicant.)	
)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Natralus Australia Pty Ltd (“Applicant”), by its attorneys, responds as follows to the Notice of Opposition filed by Brands Worldwide Holdings I.P. Pty Limited (“Opposer”):¹

For its answer to the introductory, unnumbered paragraph in the Notice of Opposition, Applicant avers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments regarding Opposer's business, address and beliefs, and denies same; Applicant admits that it is the owner of U.S. Trademark Application Serial No. 86336621,

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and Applicant denies that Opposer will be damaged by issuance of a registration for the trademark NATRALUS as applied for in U.S. Trademark Application Serial No. 86336621.

For its answer to the numbered paragraphs in the Notice of Opposition, Applicant avers as follows, with the following paragraph numbers corresponding to the numbered paragraphs in the Notice of Opposition:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
4. Applicant admits that it filed U.S. Trademark Application Serial No. 86336621 on July 14, 2014, seeking registration on the Principal Register and that said application was published for opposition in the USPTO's Official Gazette on June 16, 2015. Applicant denies that the descriptions of goods set forth in Paragraph 4 of the Notice of Opposition are the descriptions listed in that application filed on July 14, 2014.
5. Denied.
6. Denied.
7. Denied.

AFFIRMATIVE DEFENSES

Opposer's claims are barred by: laches; estoppel; acquiescence; unclean hands; the absence of a likelihood of confusion; the fact that Opposer's mark NATRALIA is weak and

entitled to limited protection; and fraud in obtaining and maintaining U.S. Trademark Registration No. 3052987 (as detailed below).

COUNTERCLAIM FOR CANCELLATION OF
U.S. TRADEMARK REGISTRATION NO. 3052987

For its counterclaim against U.S. Trademark Registration No. 3052987, Applicant avers the following:

1. Applicant is an Australian proprietary limited company and the current owner-of-record for U.S. Trademark Application Serial No. 86336621 for the mark NATRALUS for goods classified in International Classes 3 and 5.
2. Opposer has initiated Opposition No. 91224316 based on Opposer's alleged registration for, and alleged rights in, the mark NATRALIA, including U.S. Trademark Registration No. 3052987 for the mark NATRALIA for "pharmaceutical preparations, namely, skin care products, namely homeopathic preparations and herbal preparations made from native Australian herbs and essential oils, namely, medicinal creams for skin care to remove blemishes, sun spots and anti-acne cream; medicated sun care preparation; anti-itch ointment; and foot care products, namely homeopathic preparations and herbal preparations made from native Australian herbs and essential oils, namely pharmaceutical preparations for the treatment of foot care fungus" in International Class 5.
3. On information and belief, U.S. Trademark Application Serial No. 78214308 (and hence the resulting U.S. Trademark Registration No. 3052987) is void ab initio because the applicant for U.S. Trademark Application Serial No. 78214308, on February 13, 2003, lacked the

requisite bona fide intent to use the mark in U.S. commerce for the goods then specified in that application.

4. On information and belief, U.S. Trademark Application Serial No. 78214308 (and hence the resulting U.S. Trademark Registration No. 3052987) was void ab initio because the applicant for U.S. Trademark Application Serial No. 78214308, when filing items with the USPTO in relation to U.S. Trademark Application Serial No. 78214308, lacked the requisite bona fide intent to use the mark in U.S. commerce for the goods then specified in that application.

5. On information and belief, and given the lack of a bona fide intent by the applicant for U.S. Trademark Application Serial No. 78214308 to use the mark NATRALIA in U.S. commerce for the goods covered in that U.S. Trademark Application Serial No. 78214308, the applicant for U.S. Trademark Application Serial No. 78214308 made material misstatements to the USPTO in relation to U.S. Trademark Application Serial No. 78214308 with the knowledge that such statements were false and with the intent to deceive the USPTO and attain registration.

6. On information and belief, U.S. Trademark Application Serial No. 78214308 (and hence the resulting U.S. Trademark Registration No. 3052987) was void ab initio because, on February 13, 2003, there was no “corporation” in existence named Brands Worldwide Pty Limited (despite the fact that said application identified the applicant as a “corporation” named Brands Worldwide Pty Limited). As the name “Brands Worldwide Pty Limited” indicates, the entity that filed U.S. Trademark Application Serial No. 78214308 was instead likely a proprietary limited company.

7. On information and belief, U.S. Trademark Application Serial No. 78214308 (and hence the resulting U.S. Trademark Registration No. 3052987) was void ab initio because it contained an improper priority claim under Section 44(d), and later an improper filing basis under Section 44(e), due to the fact that the original description of goods for U.S. Trademark Application Serial No. 78214308 (“Pharmaceutical preparations including skin care and foot care products”) exceeded the scope of the description of goods in Australian Trademark Application No. 923263 (“Pharmaceutical preparations, including homeopathic preparations and herbal preparations made from native Australian herbs, essential oils and ingredients”).

8. On information and belief, U.S. Trademark Application Serial No. 78214308 (and hence the resulting U.S. Trademark Registration No. 3052987) was void ab initio because the Response to Office Action filed February 9, 2004, in regard to U.S. Trademark Application Serial No. 78214308 stated that the Response was being filed on behalf of “Wright Tool Company” (an entity that was not then the owner of U.S. Trademark Application Serial No. 78214308).

9. On information and belief, U.S. Trademark Registration No. 3052987 is void ab initio because, on December 6, 2011, there was no “corporation” in existence named Brands Worldwide Holdings I.P. Pty Limited (despite the fact that the “Combined Declaration of Use and Incontestability under Sections 8 & 15” filed on that date identified the registrant as a “corporation” named Brands Worldwide Holdings I.P. Pty Limited).

10. On information and belief, U.S. Trademark Registration No. 3052987 is void ab initio because, on or about November 25 and 26, 2015, there was no “corporation” in existence named Brands Worldwide Holdings I.P. Pty Limited (despite the fact that the “Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark

under Sections 8 & 9” filed on November 25, 2015, identified the registrant as a “corporation” named Brands Worldwide Holdings I.P. Pty Limited).

11. On information and belief, Opposer does not itself make (and has never itself made) any use of the mark NATRALIA in U.S. commerce for the goods covered in U.S. Trademark Registration No. 3052987, and has abandoned its rights, if any, in and to the mark NATRALIA and U.S. Trademark Registration No. 3052987 on account of such lack of use.

12. On information and belief, and given that Opposer itself has not used the mark NATRALIA in U.S. commerce for the goods covered in U.S. Trademark Registration No. 3052987, Opposer made material misstatements to the USPTO in the “Combined Declaration of Use and Incontestability under Sections 8 & 15” that was filed for U.S. Trademark Registration No. 3052987 with the knowledge that such statements were false and with the intent to deceive the USPTO and maintain that registration.

13. On information and belief, and given that Opposer itself has not used the mark NATRALIA in U.S. commerce for the goods covered in U.S. Trademark Registration No. 3052987, Opposer made material misstatements to the USPTO in the “Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9” that was filed for U.S. Trademark Registration No. 3052987 with the knowledge that such statements were false and with the intent to deceive the USPTO and maintain that registration.

14. On information and belief, Opposer has abandoned its rights, if any, in and to the mark NATRALIA and U.S. Trademark Registration No. 3052987 as a result of naked licensing of the trademark NATRALIA to others.

15. U.S. Trademark Registration No. 3052987 should be cancelled because that registration (including the application therefor) is void ab initio.

16. U.S. Trademark Registration No. 3052987 should be cancelled because of the above-referenced commissions of fraud on the USPTO in obtaining and maintaining that U.S. Trademark Registration No. 3052987.

17. U.S. Trademark Registration No. 3052987 should be cancelled due to Opponent's abandonment of the mark.

WHEREFORE Applicant prays that:

1. the Board find that there is no likelihood of confusion between the mark NATRALIA and the mark NATRALUS when used in connection with Opposer's and Applicant's respective goods;

2. the Board dismiss Opposition No. 91224316 with prejudice and pass U.S. Trademark Application Ser. No. 86336621 to the allowance stage; and

3. the Board cancel Opposer's U.S. Trademark Registration No. 3052987.

Thank you.

Dated: December 29, 2015

Respectfully Submitted,

Natralus Australia Pty Ltd

By: 

Robert B. Burlingame

PILLSBURY WINTHROP SHAW PITTMAN LLP

P.O. Box 2824

San Francisco, CA 94126-2824

Phone: 415-983-1274

Fax: 415-983-1200

sftrademarks@pillsburylaw.com

Opposition No. 91224316

PROOF OF SERVICE BY FIRST-CLASS MAIL

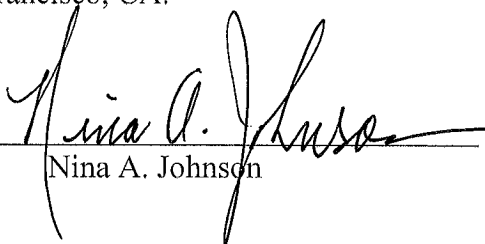
I, Nina A. Johnson, the undersigned, hereby certify and declare under penalty of perjury that the following statements are true and correct:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in San Francisco, CA.
2. My business address is Four Embarcadero Center, 22nd Floor, San Francisco, CA 94111. My mailing address is P.O. Box 2824, San Francisco, CA 94126-2824.
3. On December 29, 2015, I served a true copy of the attached document titled exactly "First Amended Answer & Counterclaim to Notice of Opposition" by placing it in an addressed and sealed envelope and transmitting it by first-class mail, to the following:

Ben S. White
IP Legal Advisors, P.C.
4445 Eastgate Mall, Suite 200
San Diego, CA 92121

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 29th day of December, 2015, at San Francisco, CA.



Nina A. Johnson